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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/046,498	TANEDA ET AL.
Office Action Summary	Examiner	Art Unit	
	KENNETH L. BARTLEY	3693	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *04/25/2008*.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Receipt of Applicant's amendment and response filed on April 25, 2008 is
acknowledged.

Response to Amendment

2.   Claims 1, 9, and 12-16 are amended. Claims 1-16 are pending in the application
and are provided to be examined upon their merits.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-16 have been considered but are
moot in view of the new ground(s) of rejection. Nevertheless, the Examiner provides a
detailed response below in **bold** where appropriate.

Applicant cites Office Action:
        In the Office Action mailed on August 9, 2007 the Examiner noted that claims 1-
15 were pending, and rejected claims 1-16. Claim 1,9 and 13-16 has been
amended, no claims have been canceled, no claim has been added and, thus, in
view of the forgoing claims 1-16 remain pending for reconsideration which is
requested. No new matter is believed to have been added. The Examiner's
rejections are respectfully traversed below.

**The Examiner respectfully points out that Applicant already responded to August
9, 2007 Office Action and the Examiner believes Applicant is now responding to
January 25, 2008 Office Action.**

Applicant responds to 35 USC §101 rejection starting on page 6 of remarks:

Applicant argues claim 1:

The Office Action, on page 9, rejected claim 1 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claim provide no useful, concrete and tangible result. However, claim t has been amended to recite "notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101. Support can be found at page 12, lines 5-32 of the application.

The Examiner thanks the Applicant for the amendment. The Examiner respectfully still does not find that the claim provides a useful result. While the claim converts virtual into personal information, this is mapping one form of information (virtual) into another form (real). For example, if the invention was an algorithm for converting data, then converting could be a useful step provided Applicant is claiming a new algorithm in their specification. However, if Applicant's invention is directed towards converting for purposes of a commercial transaction, this is not taught. Further, there step in the claim why notifying real personal information to an entity is useful. What is the benefit of doing this?

Applicant argues claims 2-8:

The Office Action, on page 10, rejected claims 2-8 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 2 is so broad that it encompasses any type of commercial transaction thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument, it is submitted that the recitation of "making a commercial transaction in a virtual world on a network" in claim 2 has a practical application. Specifically, because the commercial transaction is "in a virtual world" setting taken place over a "network", real personal information of a user is protected. Therefore, one of ordinary skill in the art would clearly understand that claim 2 has a practical application. Thus, claim 2 and claims 3-8, which depend from claim 2, satisfy the requirements of 35 U.S.C. § 101.

The Examiner withdraws the rejection to claims 2-8.

Applicant argue claims 9-11:

The Office Action, on page 10, rejected claims 9-11 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claims provide no useful, concrete and tangible result. However, claim 9 has been amended to recite a "notifying means for notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101.

For the same reasons as claim 1, claim 9 does not produce a useful result and the Examiner maintains this rejection.

Applicant argues claims 12-15, page 6 of remarks:

The Office Action, on page 10, rejected claims 12-15 under 35 U.S.C. § 101 because the claims were allegedly directed to non-statutory subject matter. However, claims 12-15 have been amended to recite "a system for managing a virtual city space within a virtual world" to overcome the rejection under 35 U.S.C. § 101.

The Examiner withdraws the rejection to claims 12-15.

Applicant argues claim 16, page 6:

The Office Action, on page 11, rejected claim 16 under 35 U.S.C. § 101 because the claim lacks patentable utility. Specifically, the Office Action asserted that claim 16 provides no useful, concrete, and tangible result. However, claim 16 has been amended to recite "notifying the real personal information to an entity" to overcome the rejection.

For the reasons cited above, it is still not clear that a useful result is recited.

Further, the Office Action rejected claim 16 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 16 is so broad that it would apply to everyone on the Internet thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument. It is submitted that at least one practical application of claim 16 is "managing registered information of the virtual user" and "managing registered information of the ... real user" to convert "virtual information into real information of a person". Moreover, the claim language is not so broad that it would apply to everyone, rather the language in claim 16 applies to "virtual users ... [and] virtual entities within the virtual world". Therefore, the language recited in claim 16 is not so broad as to have no practical application, as asserted by the Office Action.

The Examiner removes this rejection.

Thus, in view of the foregoing, it is submitted that claims 1-16 satisfy the requirements of 35 U.S.C § 101. Accordingly, withdrawal of the rejections is respectfully requested.

The Examiner removes <u>the 35 USC § 101 rejections to claims 2-8 and 12-15 and maintains the rejections to claims 1, 9-11 and 16</u>.

Applicant argues 35 USC §112, 1<u>st</u> paragraph on page 7:

Applicant argues claim 11:

The Office Action, on page 11, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement. Claim 1 has been amended to overcome the rejection. Support for the amendment can be found at Fig. 1 of the application.

The Examiner <u>removes the 35 USC §112, 1st paragraph rejection</u> based on the amended claim.

<u>Applicant argues 35 USC §112, 2nd paragraph starting on page 7:</u>

The Office Action, on page 12, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 1 omits essential steps such as "creating virtual information from [the] registered information". According to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention". In this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claim. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "creating virtual information from [the] registered information" is an essential step. Claim 1 is directed to "communicat[e] to a manager ... virtual personal information ... and convert the virtual personal information into the real personal information based on registered information". Therefore, it is submitted that claim 1 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

With all due respect, even though the specification teaches registering information, the claims still must recite steps of the process that Applicant is claiming and cannot rely on the specification to fill in various steps that are missing. Ideally, the process should be a series of steps that follow logically from each other. In claim 1, virtual information appears without any step as to it's creation, where the specification requires information to be registerd.

The Examiner maintains the prior rejection of claim 1.

<u>Applicant argues clams 1-16:</u>

The Office Action, on page 12, rejected claims 1-16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. Particularly, the Office Action asserted that "virtual personal information" and "real personal information", as recited in claims 1, 2, 9, 12 and t6, could include anything. The assertion by the Office Action is traversed with an argument. Specifically, "virtual personal information" as recited in claim 1 is a "representation ... similar to that of real personal information". Stated another way, virtual personal information is information that represents

the real information of the person (see Specification, page 8, line l3 to page 10, line 20). Therefore, one of ordinary skill in the art would clearly understand the meaning of "virtual personal information" and "real personal information" in light of the specification and would also clearly understand by simply reading the claim language recited in claims 1, 2, 9, 12 and t6. Thus, it is submitted that claims 1-16 satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

The Examiner withdraws this argument.

Applicant argues claims 2-8 on page 8 of remarks:
The Office Action, on page 12, rejected claims 2-8 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 2 omits essential steps such as "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve tea] monetary transactions". However, as previously mentioned, according to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.8.C. 112, second paragraph, for failure to point out and distinctly claim the invention", tn this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claims. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve real monetary transactions" are essential steps. Claim 2 is directed to a commercial transaction method that allows a user to "mak[e] a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network". Accordingly, it is submitted that claim 2 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

From above, the Examiner points out the need to register real and personal information as taught in Applicant's specification and maintains this rejection.

Applicant argues claim 16, bottom of pate 8:
The Office Action, on page 13, rejected claim 16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. The Office Action asserted that there is no indication of how virtual information is communicated. However, claim 16, as amended, recites "communicating, via a network, virtual information of a virtual user to at least one of a plurality of virtual entities within a virtual world". Therefore, claim t6, as amended, clearly points out how virtual information of a virtual user is communicated.

The Examiner removes this argument.

Further, the Office Action asserted that the recitation "managing registered information" in claim16 is unclear. However, the Examiner's attention directed to the recitation "managing registered information of the virtual user and real user to convert virtual information into real information of a person" in claim 16. It is submitted that one of ordinary skill in the art would clearly understand when reading the above-quoted claim language that "registered information of the virtual user" and "registered information of ... [the] real user" is managed "to convert virtual information [of the virtual user] into real information of a [real] person". Therefore, claim 16 fully satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

The Examiner removes this argument.

Accordingly, withdrawal of the rejections is respectfully requested.

The Examiner maintains the 35 USC 112, 2ⁿᵈ para. rejection for claims 1-8 and 16.

Also, in reviewing claim 12 the system consists only of a network. However, Fig. 1 of Applicant's specification shows other components. Also, "A system for managing a virtual city space...comprising: a plurality of virtual shops... a commercial transaction..." A plurality of virtual shops and a commercial transaction do not provide a system for managing a virtual city space. There appears to be a disconnect between the preamble and system components.

Applicant argues 35 USC § 102(e) to claims 1-16, beginning page 9:

The Examiner used US Pub. No. 2001/0037316 to Shiloh as prior art.

In the Response to Argument, on page 2 of the Office Action, the Examiner asserted that similar support can be found in Shiloh's provisional application. However, the Examiner has not indicated where such support can be found. The Examiner's attention is respectfully directed to the priority document filed with the Response on November 9, 2007, claiming priority over Shiloh. As such, Shiloh has been disqualified as prior art under 35 U.S.C. § I02 (e) because of the above-mentioned filed priority document. Therefore, it is submitted that the Examiner must issue a new non-final Office Action since the Applicant has claimed priority over Shiloh. Further, the Examiner is respectfully requested to indicate with specificity where in the provisional application of Shiloh the features of claims 1-16 are disclosed.

The Applicant is arguing that Shiloh cannot be used as prior art because their provisional application does not overcome Applicant's claims and that the Examiner needs to use the provisional application.

The Examiner used published documents as prior art. In this case, US Pub No. 2001/0037316 was used to overcome Applicant's claims (dated 3/22/2001). This application claims priority to provisional application 60/191,625, with a date of 3/23/2000, which is prior to Applicant's foreign priority date of 1/17/2001. Because Shiloh is important prior art and at Applicant's request, the Examiner provides a response based on the provisional application of Shiloh. The Examiner points out that while Shiloh's provisional application may not teach all of the details of their non-provisional application, it teaches the core of the invention (Fig. 1) and core idea (e.g. virtual personality). For example, the non-provisional teaches:

"The real entity has a real identity, which may <u>include a given first and last name, a mailing address, a billing address, a telephone number, a social security number, a driver's license information,</u> or any other information typically used to identify a legal entity, such as a person, a corporation or a non-profit organization." [¶ 0019]

The provisional teaches in the figure labeled "Proposed Model For Virtuality" under " -Real personal information: –Credit card number; -Billing address; -Social Security number".

<u>Applicant argues provisional, pg. 9:</u>
> The Office Action, at item 15a on page 14, asserted that the bottom of paragraph 18 Shiloh discloses "a communication network that includes the Internet, intranets, and local networks". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Examiner respectfully does not know how art becomes disqualified or what that means. However, the Examiner will point out sections of the provisional application that relate to Applicant's invention.

Both publication and provisional teach "Internet." For example, Fig. 1 of the provisional teaches "Internet."

> The Office Action, at item 15b on page 14, asserted that the middle of paragraph 20 of Shiloh discloses "a real entity represented by a virtual entity "... with an

imaginary name, an imaginary address, a virtual social security number, and any other data that may be required for the Internet activity of the virtual entity", However, merely citing a publication that has been disqualified does not qualify as prior art under 35 US.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The provisional teaches:
"Virtuality, on its real world side, will know the <u>linking between your real information and your virtual information</u>. The Internet side of Virtuality will communicate only with the virtual person you have created."(pg. 3, para. 2)

Since real personal information (Fig. 1 of provisional) includes billing address, for example, there must be a virtual address with which to link the real billing address.

The Office Action, at item 15c on page 14, asserted that paragraphs 21 and 25 and 27 of Shiloh disclose "a computer system that manages both the real and virtual personal ... and provides a link between the virtual user and the real user". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Examiner points to the Title, for example, of the provisional:
"METHOD AND SYSTEM FOR SECURING USER IDENTITIES AND CREATING VIRTUAL USERS TO ENHANCE PRIVACY ON A <u>GLOBAL COMPUTER NETWORK</u>"

Also, the figure "Proposed Model For Virtunality" in the provisional teaches "virtunality.com" with arrows to an Internet, and arrows for user "X" and user "Y" (X@virtunality.com and Y@virtunality.com)

The Office Action, at item 15d on page 14, asserted that paragraph 22 of Shiloh discloses the "ability to conduct commercial transactions on the Internet using a virtual personality". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional application…

Payments by virtual personalities over the Internet may be in the form of a virtual credit/debit card registered to your fictional personality. This may be implemented with real credit card numbers that may be issued to Virtunality by existing credit card companies." (pg. 5, para.2)

> The Office Action, at item 15e on page 14, asserted that the middle of paragraph 31 of Shiloh discloses "shipping items to a real address based on a virtual transaction by a virtual entity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional application...
"To accommodate products that are available only via shipping, Virtunality will establish physical mailboxes that will be assigned to subscribers, under their virtual identity, based on a reasonable monthly fee." (pg. 5, para. 1)

> The Office Action, at item 15f on page 14, asserted that the middle of paragraph 26 of Shiloh discloses "the ability of a virtual person to authenticate (confirm) a transaction on the Internet using a fictional user name and information". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional application...
"All financial tools (e.g., credit cards, debit cards) registered to virtual users of Virtunality will be billed to Virtunality, and the payments will be deducted within Virtunality from the debit accounts of the corresponding real users. Using this system, users will also be able to receive payments and refunds credited to their virtual personalities." (pg. 3, para. 3)

> The Office Action, at item 15g on page 14, asserted that paragraph 85 of Shiloh discloses "the user logs into a site by ... presenting the virtual user access ID and virtual user access password ... to gain access to their virtual identity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional application…
"Virtunality will endorse and encourage anonymity on the Internet and will
provide its users with powerful tools to interact anonymously with the Internet."
(pg. 1, para. 3) Also, the Examiner takes Official Notice below that log-in and
password are old and well known.

> The Office Action, at item 15h on page 14, asserted that paragraph 20 of Shiloh
> discloses "a virtual entity may obtain a virtual debit and credit card number".
> However, merely citing a publication that has been disqualified does not qualify
> as prior art under 35 U.S.C. § 102(e) unless the provisional application supports
> such disclosure. Since the provisional application of Shiloh is a separate
> reference in itself, the Examiner is respectfully requested to specifically point out
> where the alleged feature is disclosed in the provisional application.

From the provisional application…
"Most importantly, in the first stage, your virtual personality will be provided with
buying power, e.g., in the form of a virtual credit/debit card number registered
under your virtual identity, enabling full access of your virtual personality to
existing Internet services." (pg. 3, para. 3)

> The Office Action, at item 15i on page 14, asserted that the middle of paragraph
> 31 of Shiloh discloses that "virtual users are able to make purchases of goods,
> presumably from virtual stores". However, merely citing a publication that has
> been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless
> the provisional application supports such disclosure. Since the provisional
> application of Shiloh is a separate reference in itself, the Examiner is respectfully
> requested to specifically point out where the alleged feature is disclosed in the
> provisional application.

From the provisional application…
Figure titled "Proposed Model For Virtunality" teaches "Internet Shopping" and
Pets.com and Pricline.com.

> The Office Action, at item 15j on page 15, asserted that the middle of paragraph
> 35 and paragraph 20 of Shiloh discloses that "users can have personalized
> virtual home pages that server as homes for entities and a ... virtual entity may
> enter a chat room and interact with other real and/or virtual entities". However,
> merely citing a publication that has been disqualified does not qualify as prior art
> under 35 U.S.C. § 102(e) unless the provisional application supports such
> disclosure. Since the provisional application of Shiloh is a separate reference in
> itself, the Examiner is respectfully requested to specifically point out where the
> alleged feature is disclosed in the provisional application.

From the provisional application…

Figure titled "Proposed Model For Virtunality" teaches "Chat rooms" connected to the Internet and virtual User "X" (X@Virtunality.com) for example.

> The Office Action, at item 15k on page 15, asserted that paragraph 21 of Shiloh discloses that "the system ... may be an organization operating a server site or series of server sites providing access to the Internet and/or other services ...". Further, the Office Action asserted that paragraph 23 of Shiloh discloses that "while virtual stations and virtual city space are not discussed, Shiloh has the capability of offering it in that they provide virtual address information an provide management of the system and that entities can change personalities, which would include their virtual address". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional application…
Figure titled "Proposed Model For Virtunality" teaches in "VIRTUNALITY.COM" which contains "Virtuality Personality generator" under which is "Virtual personality traits" and access to the Internet.

> The Office Action, at item 151 on page 15, asserted that paragraph 21 of Shiloh discloses:
>> The system of the present invention is generally referred to herein as an Anonymous Virtual Personality Provider (AVPP). In an exemplary embodiment of the invention, an AVPP may include an organization and/or combination of computer hardware and/or software which provides services according to the system and method of the invention, such as an ISP, an Internet portal, financial services, shipping infrastructure, or any other system or organization that may be required in order to conduct business and/or to provide services on the Internet. For example, the AVPP may be an organization operating a server site or series of server sites providing access to the Internet and/or other services that may be required in order to implement and manage the virtual entities.

> However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § t02(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Examiner asserts that this is taught throughout the provisional, as indicated above where various parts of the provisional art cited, and in the Fig. "Proposed Model For Virtuality."

> The Office Action, at item 15m on pages 15 and 16, asserted that paragraph 33 of Shiloh discloses:
>> [P]ayments by a virtual personality over the Internet may be in the form of a virtual credit/debit cards registered to the virtual personality. This may be implemented using a real credit card number that may be issued to the AVPP by an existing credit card company. The AVPP may be directly responsible for the payment of its virtual users' credit card bills. For billing and credit card authentication purposes, each virtual credit card of an AVPP user may be registered with the address of the AVPP and the fictional identification information assigned to each user. Therefore AVPP manages ... converting virtual information into real world information.

> However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

From the provisional…
"Virtuality, on its real world side, will know the <u>linking between your real information and your virtual information</u>. The Internet side of Virtuality will communicate only with the virtual person you have created."(pg. 3, para. 2) See above regarding debit and credit cards.

> Therefore, in view of the foregoing, the Examiner is respectfully requested to issue a new non-final Office Action because the Office Action, mailed January 25, 2008, improperly rejects claims 1-16 as failing to show where the features are allegedly disclosed in the provisional application of Shiloh.

The Examiner respectfully points out to the Applicant that if the Examiner believed the provisional did not teach enabling aspects of Shiloh's Application, the Examiner would not have used the provisional date. However, as seen above, there is enough written disclosure and enablement in the provisional to support use of that date. Normally, Examiner's do not cite provisional applications but cite the non-provisional published application. However, since Applicant has requested use of the provisional application, the Examiner does so in this Office Action.

<u>Applicant continues on page 13, 3rd paragraph:</u>

Further, it is submitted that the provisional application of Shiloh fails to teach or suggest the features of claims 1-16 for the following reasons.

Applicant reviews Shiloh invention:

The provisional application of Shiloh is directed to a method and system that secures user identities and creates virtual users to enhance the privacy on a global computer network (see provisional application of Shiloh, page 1). Particularly, the provisional application of Shiloh describes a Virtunality System, which is a virtual personality provider, that is used to promote all Internet business and allow a user to use a virtual account to research and shop the Internet without disclosing the real identity of the user (see provisional application of Shiloh, page 1, paragraph 1 to paragraph 3). Stated another way, a user can conduct transaction with other Web sites using a virtual identity provided by Virtunality.

Applicant argues claim 1, page 13:

However, claim 1 is directed to a communication method that "communicat[es] to a manager, via a network, virtual personal information ... [that] includes a virtual address in a virtual city within a virtual world" so the manager can "convert the virtual personal information into the real personal information based on registered information". The provisional application is silent as to the above-quoted features in claim 1. Specifically, paragraphs 1-3 and Fig. t of the provisional application of Shiloh are silent as to how "the virtual personal information" is "[converted] into the real personal information" and is silent as to who does the "converting".

The Examiner respectfully points out that Shiloh teaches:
Virtunality will consist of two separate sub-systems, namely, <u>a virtual world</u> system and <u>a real world system</u>. The two systems will not communicate with each other via the Internet. This concept is depicted clearly in the attached drawing of a Proposed Model for Virtunality." (pg. 2, para. 4)

"<u>Virtunality,</u> on its real world side, <u>will know the</u> <u>linking between your real information and your virtual information</u>. The Internet side of Virtunality will communicate only with the virtual person you have created."(pg. 3, para. 2) Therefore, the real and personal information are linked.

Applicant continues on claim 1:

In claim 1, it is clear from the recitation that "converting ... [is] based on registered information" and that the manager does the converting. However, the provisional application of Shiloh is merely concerned with a proposed model for Virtunality having real world services with anonymous users and does not teach how information will be converted and by whom it will be converted. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails

to disclose or suggest at least the above-quoted features of claim 1. Thus, it is submitted that claim 1 is patentable over the provisional application of Shiloh.

The Applicant is pointing out Shiloh does not teach how information will be converted and by whom it will be converted. The Examiner looks at Applicant's specification for detail information regarding how data is converted, but does not find this. The Examiner does find a "converter" manager (Fig. 1, ref. 6 and 7). Applicant's claims only specifies "managing apparatus" which is broad and the Examiner respectfully argues "Virtuanlity" system provides this.

Applicant argues claim 2, starting bottom of page 13:

Further, claim 2 recites "making a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network". However, Fig. 1 of the provisional application of Shiloh merely describes a user having Internet anonymity and describes a communication link between the user and the real world services, which are labeled under "Virtuanlity - Reality". One of ordinary skill in the art would clearly understand by viewing Fig. 1 in the provisional application of Shiloh that a user is using a virtual identity to communicate in a real world environment rather than a "transaction in a virtual world'. Further, Fig. 1 clearly describes "real world services", "banking services", "privacy protection/promotion organization" but does not describe in any way that a "commercial transaction [is being made] in a virtual world" as in claim 2. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 2. Thus, it is submitted that claim 2 is patentable over the provisional application of Shiloh. Further, dependent claims 3-8 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 2, from which they depend.

The Examiner respectfully points out that the figure shows "Internet Shopping." Also, User "Y" has a billing address and credit card number and Y@Virtuanlity.com linked to such the Internet shopping. Also, there are teachings (cited above) in the provisional that teach payment, shopping, etc..

Applicant argues claim 9, page 14:

With respect to claim 9, the last three lines on page 3 of the provisional application of Shiloh describes that linking between real identities and their corresponding virtual identities, for both debit and credit purposes, will be performed only within the internal accounting system of Virtuanlity, thereby fully protecting this crucial linking from being communicated to the internet.

However, claim 9 recites "converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the

registered information". As previously mentioned, Shiloh fails to disclose as to how and what "convert[s] the virtual personal information received from the virtual city within the virtual world ... into corresponding real personal information of the real world". Rather, the last three lines on page 3 of the provisional application is merely concerned with who protects the information and does not teach how the information is converted and by what means the information is converted.

The Examiner respectfully points out that Applicant does not teach details of converting either. Also, Shiloh teaches linking virtual and real world information, and real world information includes "billing address" under User "Y" in the provisional figure. The Examiner argues that billing address information includes a name, street number, street name, city, state and zip code. The Applicant is arguing that in reading the provisional of Shiloh he does not teach or suggest converting between real and virtual personal information, where personal information includes addresses. The Examiner respectfully disagrees with this. In fact, in addition to the above, Shiloh states:

"At Virtuality, <u>your virtual personality is not limited to the equivalent of a virtual e-mail address</u>, such as "hotmailTM, "yahoo!TM, or similar accounts (which, incidentally, are not intended for the purpose of creating virtual identities)." (pg. 1, last para.)

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 9. Thus, it is submitted that claim 9 is patentable over the provisional application of Shiloh. Further, the dependent claims 10 and 11 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 9, from which they depend.

The Examiner provides a rejection below.

<u>Applicant argues claim 12, starting page 14:</u>
With respect to claim 12, the last paragraph on page 12 of the provisional application of Shiloh describes that Virtuality users with be provided with a virtual spending account to make Internet shopping attractive to privacy-oriented users. Further, paragraph 1 on page 5 of the provisional application of Shiloh describes that Virtuality will allow users to make transactions with websites such as Priceline.com while protecting the real identity of the user.

However, in claim 12 "a commercial transaction [is] made between a first virtual individual and an arbitrary one of the virtual shops". The above-quoted feature is not taught or suggested in the provisional application of Shiloh because the provisional application of Shiloh is merely concerned with allowing a real user to

use a virtual identity to make transactions in the real world. Specifically, the provisional application of Shiloh describes a real user can use a virtual identity to make transaction on Priceline.com (e.g. real store), for example and is not concerned with a real user using a virtual identity to make a "commercial transaction .,. [with] an arbitrary one of the virtual shops" as required in claim 12.

The Examiner respectfully points to Y@Virtunality.com connected to the Internet with access to Internet shopping in the provisional figure. Also…

"According to another possible implementation (user type "Y" in the attached drawing), your real identity will be disclosed only to Virtunality in the real world, e.g., in person, by mail, by phone, by direct connection, etc. (depending on your level of comfort). Virtunality will then provide you with (or help you build) a fictional user name and fictional user information. Only Virtunality, on its real world side, will know the linking between your real information and your virtual information. The <u>Internet side of Virtunality will communicate only with the virtual person</u> you have created." (pg. 3, para. 2)

<u>Applicant continues on page 15:</u>
Further, the third and fourth paragraphs on page 5 of the provisional application of Shiroh describes a Virtunality Product Line that is directed to allow a user to purchase virtual personalities to allow a user to lead a full virtual life. Specifically, the personalities in the provisional application of Shiloh are not purchased from a virtual shop but rather purchased from Virtunality (e.g. a real entity). Therefore, neither paragraph teaches or suggests "[making] a commercial transaction ... between a first virtual individual and ... the virtual shops" because the cited paragraph are merely concerned with Virtunality selling personalities to a user, rather than describing a commercial transaction with "an arbitrary one of the virtual shops". Further, the entire reference is silent as to making any type of transaction with any virtual shop.

With all due respect, selling personalities is another feature of Virtunality, in addition to commercial transactions with stores, for example:

"Most existing products and services on the Internet do not inherently require real world identification, such as a mailing address. For example, soft products (a constantly and exponentially growing industry), <u>grocery shopping</u> (Priceline TM, etc.), "print-your-own" products (e.g., uniquely bar-coded stamps, movie tickets, etc.), music and videos, even hotel reservations." (pg. 5, para. 1)

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-mentioned features recited in claim 12. Thus, it is submitted that claim 12 is patentable over the provisional application of Shiloh. Further, dependent claims 12- 15 are also patentable over the provisional

application of Shiloh for at least the same reasons as base claim 12, from which they depend.

The Examiner respectfully disagrees based on the above cited reasons.

Applicant continues on pag 15, para. 5:

In the Response to Arguments, on page 7 of the Office Action, the Examiner asserted that the Applicants specification indicates that a virtual shop in a virtual world can be indicated by a URL. Such an assertion by the Examiner is incorrect. The Examiner is respectfully requested to read page 9, line 36 to page 10, line 20 of the Specification in its entirety. The URL described in the Specification is an example of a way to describe a "virtual address", i.e. the location of the virtual shop within the virtual world". Such a "virtual address" recited in the independent claims 1,2, 9 and 12 is not taught or suggested by the provisional application of Shiloh, but rather the provisional application of Shiloh is merely concerned making a transaction in the real world using a virtual identity. Therefore, based on this additional reason, the provisional application of Shiloh does not teach or suggest at least the above-mentioned feature recited in claims 1, 2, 9 and 12.

The Examiner maintains that virtual shops are taught by Shiloh and points to Internet Shopping and Pets.com in the provisional figure "Proposed Model For Virtunality."

Applicant argues claim 16, beginning on page 15:

With respect to claim 16, the last paragraph on page 6 of the provisional application of Shiloh describes that depending on the magnitude of business generated by Virtunality, and its growth Virtunality may be able to provide its users with any other existing Internet services. However, the cited paragraph does not teach or suggest how and by what means Virtunality will provide its user with any other existing Internet services. Such a blanket statement that that Virtunality may be able to provide does not teach or suggest how and by what means Virtunality will provide other existing Internet services. To that extent, the last paragraph on page 6 of the provisional application of Shiloh fails to teach or suggest how and by what means "virtual information of a virtual user" is communicated "to at least one of a plurality of entities within a virtual world' as recited in claim 16.

The Examiner does not rely on the last paragraph of page 6 to provide teachings from the provisional. Therefore, it is submitted that claim 16 is patentable over the provisional application of Shiloh.

The Examiner, for the above cited reasons, respectfully maintains the rejections.

claim 1, where does virtual information come from? No transformation of data.. converting he does is looking up in the database. Converting is interpreted as mapping.

Claim 2 does nothing with the personal information... why useful result. It does not have useful con

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 9-11, and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites converting virtual information into real information and notifying the real information to an entity. Converting information does not involve literally converting virtual information but involves providing mapped information. Also, notifying an entity of real personal information does not by itself teach usefulness. The claims fail to produce useful, concrete and tangible results since the data are not transformed into another parameter that produces useful, concrete and tangible results (MPEP 2106 IV C 2). In other words, the process, method and product recited in the respective claims do not meet the statutory definition of a process, method or product.

Specifically, regarding the process and method claims, the Court has held that the "transformation and reduction of an article to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines. State

Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368 (Fed. Cir. Jul. 23, 1998).

The instant claims do not meet this standard of a statutory definition of a process claim. Therefore, it is concluded that the subject claims are not directed to a statutory matter under 35 USC 101 since (i) they are not patentable as process claims and (ii) they do not produce useful, concrete, and tangible results.

Claims 9 and 16 have the same problem. Dependent claims 10-11 are rejected because they depend from independent claim 9.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-8 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: there is no step to create virtual information. Claims 3-8 are rejected because they depend from claim 2.

7.   Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8.   Claim 12 in the preamble states "A system for managing a virtual city..." where the components do not provide such a system. For example, does Applicant mean a system for a commercial transaction... where Fig. 1 would provide the system?

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

10.   Claims 1-5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over US Pub. No. 2001/0037316 to Shiloh **(and it's provisional application**

60/191625, which is used as the reference below) and US Pub. No. 2001/0034661 to

Ferreira.

Regarding claim 1:
 A communication method, comprising:
communicating to a manager, via a network, virtual personal information of a virtual
world having a representation format similar to that of real personal information of a real
world;

> **Shiloh teaches:**
> **Virtunality will consist of two separate sub-systems**, namely, **a virtual world**
> **system and a real world system. The two systems will not communicate**
> **with each other via the Internet. This concept is depicted clearly in the**
> **attached drawing of a Proposed Model for Virtunality." (pg. 2, para. 4)**
>
> **Communicating virtual personal information ("Internet" in Figure**
> **"Proposed Model for Virtunality").**
>
> **At Virtunality, your virtual personality is not limited to the equivalent of a**
> **virtual e-mail address, such as "hotmailTM', "yahoo !TM,, or similar**
> **accounts (which, incidentally, are not intended for the purpose of creating**
> **virtual identities). (pg. 1, last para.) Therefore, other virtual addresses**
> **exists, such as virtual PO Boxes, just like the real world.**

converting the virtual personal information into the real personal information based on
registered information, in a managing apparatus provided in the network; and

> **"Virtunality, on its real world side, will know the <u>linking between your real</u>
> <u>information and your virtual information</u>. The Internet side of Virtunality will
> communicate only with the virtual person you have created."(pg. 3, para. 2)**

> **"The <u>linking between real identities and their corresponding virtual</u>
> <u>identities</u>, for both debit and credit purposes, <u>will be performed</u> only within
> the <u>internal accounting system of Virtunality</u>, thereby fully protecting this
> crucial linking from being communicated to the Internet." (pg. 3, para. 4)
> Inherent in this process is converting virtual to real information using the
> Virtunality system**

> **(see Register below)**

notifying the real personal information to an entity,

> **Virtunality.com is an entity that knows the real personal information for
> linking purposes.**

wherein the virtual personal information includes a virtual address in a virtual city within
the virtual world.

> **"To accommodate products that are available only via shipping, <u>Virtunality</u>
> <u>will establish physical mailboxes that will be assigned to subscribers,</u>
> <u>under their virtual identity</u>, based on a reasonable monthly fee." (pg. 5,
> para. 1) Virtuanlity is a virtual world. Inherent in virtual mailboxes in a
> virtual world are virtual addresses.**

> **(see Virtual City below)**

Virtual City
Shiloh discloses real and virtual worlds, linking real personal information
between real and virtual worlds. Shiloh also teaches billing address (figure
"Proposed Model For Virtuanlity") as real personal information.
Shiloh fails to disclose "virtual city."
Ferreira, also in the business of virtual worlds teaches a virtual city:

> **"The virtual city application may provide one-stop shopping services while
> not burdening users with repeated requests for personal information."
> [¶0012]**

**It would have been obvious to one of ordinary skill in the art at the time of
invention to teach "virtual city" in the virtual world of Shiloh motivated by
Ferreira and that a virtual city would represent a provide a complete virtual billing
address component that would be linked to the real billing address components**

(name, street, city, state, etc) taught by Shiloh in their "Proposed Model For Virtunality" drawing.

Register
Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh does not teach registered information.

Ferreira, also in the business of virtual worlds teaches:
> **"By linking all order processes from all e-commerce web sites accessible through the virtual city application, the user is given the ability to shop for items at multiple places, each purchase being made through a single source. This allows the user to register only once." [¶ 0085]**

It would have been obvious to one of ordinary skill in the art at the time of invention to teach register motivated by Ferreira and that this would provide the information of the real personal information such as billing address, for example, and this would allow Virtunality to make payments for users.

Regarding claim 2:
 An electronic commercial transaction method, comprising:
making a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network,
> **Shiloh teaches:**
> **"Most importantly, in the first stage, your virtual personality will be provided with <u>buying power</u>, e.g., in the form of a <u>virtual credit/debit card number registered under your virtual identity</u>, enabling full access of your <u>virtual personality to existing Internet services</u>." (pg. 7, para. 3) Ability to make commercial transactions in a virtual world on a network (internet) based on personal information.**

wherein said virtual personal information having a representation format similar to that of real personal information of a real world, and includes a virtual address in a virtual city within the virtual world.
> **<u>Virtunality will consist of two separate sub-systems</u>, namely, <u>a virtual world</u> system and <u>a real world system</u>. The two systems will not communicate with each other via the Internet. This concept is depicted clearly in the attached drawing of a Proposed Model for Virtunality." (pg. 2, para. 4)**

> **"Virtunality, on its real world side, will know the <u>linking between your real information and your virtual information</u>. The Internet side of Virtunality will communicate only with the virtual person you have created."(pg. 3, para. 2) Inherent in having linked information, is the ability to convert back and forth between the real and virtual information.**

Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh also teaches billing address (figure "Proposed Model For Virtuanlity") as real personal information.
Shiloh fails to disclose "virtual city."
Ferreira, also in the business of virtual worlds teaches a virtual city:
> **"The virtual city application may provide one-stop shopping services while not burdening users with repeated requests for personal information." [¶0012]**

It would have been obvious to one of ordinary skill in the art at the time of invention to teach "virtual city" in the virtual world of Shiloh motivated by Ferreira and that a virtual city would represent a virtual billing address component that would be linked to the real billing address components (name, street, city, state, etc) taught by Shiloh.

Regarding claim 3:
The electronic commercial transaction method as claimed in claim 2, further comprising: converting the virtual personal information into the real personal information in a managing apparatus provided in the network.
> **Shiloh teaches:**
> **"Virtunality, on its real world side, will know the <u>linking between your real information and your virtual information</u>. The Internet side of Virtunality will communicate only with the virtual person you have created."(pg. 3, para. 2) Therefore, Virtuanlity is able to convert between virtual and real information since it knows the linking between the two worlds.**

Regarding claim 4:
The electronic commercial transaction method as claimed in claim 3, further comprising: instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction, based on the real personal information.
> **Shiloh teaches:**
> **"<u>Payments</u> by virtual personalities over the Internet may be in the form of a virtual credit/debit card registered to your fictional personality. This may be <u>implemented with real credit card numbers</u> that may be issued to Virtunality by existing credit card companies." (pg. 5, para.2) Payment involves settlement and real credit card numbers issued by credit card companies will require real personal information.**

Regarding claim 5:
The electronic commercial transaction method as claimed in claim 2, further comprising: seeking confirmation on an approval of the settlement to an individual in the real world who made the commercial transaction, based on the virtual personal information.
> **Shiloh teaches:**

> **"All financial tools (e.g., credit cards, debit cards) registered to virtual
> users of Virtunality will be billed to Virtunality, and the <u>payments will be
> deducted within Virtunality from the debit accounts of the corresponding
> real users</u>. Using this system, users will also be able to receive payments
> and refunds credited to their virtual personalities." (pg. 3, para. 3)**

Regarding claim 8:
The electronic commercial transaction method as claimed in claim 2, wherein said
virtual personal information further includes at least one of a virtual name used in the
virtual world, a virtual telephone number at the virtual address in the virtual city, a virtual
bank account number of a virtual bank within the virtual city, and a virtual credit card
number of a virtual credit card usable in the virtual world.

> **Shiloh teaches:**
> **"Payments by virtual personalities over the Internet may be in the form of a
> virtual credit/debit card registered to your fictional personality." (pg. 5,
> para. 2)**

Regarding claim 9:
A managing apparatus, comprising:
managing means for managing registered information which is used when converting
virtual personal information into real personal information of a virtual world of a real
world, said virtual personal information having a representation format similar to that of
the real personal information and including a virtual address in a virtual city within the
virtual world;

> **Shiloh teaches:**
> **"Virtunality, on its real world side, will know the <u>linking between your real
> information and your virtual information</u>. The Internet side of Virtunality will
> communicate only with the virtual person you have created."(pg. 3, para. 2)**
>
> **"The <u>linking between real identities and their corresponding virtual
> identities</u>, for both debit and credit purposes, <u>will be performed</u> only within
> the <u>internal accounting system of Virtunality</u>, thereby fully protecting this
> crucial linking from being communicated to the Internet." (pg. 3, para. 4)
> Inherent in this process is converting virtual to real information using the
> Virtunality system**
>
> **(see Virtual City below)**

converting means for converting the virtual personal information received from the
virtual city within the virtual world via a network into corresponding real personal
information of the real world, based on the registered information; and

> **"Virtunality, on its real world side, will know the <u>linking between your real
> information and your virtual information</u>. The Internet side of Virtunality will
> communicate only with the virtual person you have created."(pg. 3, para. 2)**

Inherent in having linked information, is the ability to convert back and forth between the real and virtual information.

(see Register below)

notifying means for notifyinq the real personal information to an entity.

Virtunality.com is an entity that knows the real personal information for linking purposes.

Virtual City

Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh also teaches billing address (figure "Proposed Model For Virtuanlity") as real personal information.
Shiloh fails to disclose "virtual city."
Ferreira, also in the business of virtual worlds teaches a virtual city:

"The virtual city application may provide one-stop shopping services while not burdening users with repeated requests for personal information." [¶0012]

It would have been obvious to one of ordinary skill in the art at the time of invention to teach "virtual city" in the virtual world of Shiloh motivated by Ferreira and that a virtual city would represent a virtual billing address component that would be linked to the real billing address components (name, street, city, state, etc) taught by Shiloh.

Register

Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh does not teach register.

Ferreira, also in the business of virtual worlds teaches:

"By linking all order processes from all e-commerce web sites accessible through the virtual city application, the user is given the ability to shop for items at multiple places, each purchase being made through a single source. This allows the user to register only once." [¶ 0085]

It would have been obvious to one of ordinary skill in the art at the time of invention to teach register motivated by Ferreira and that this would provide real personal information such as billing address, for example, and this would allow Virtunality to make payments for users.

Regarding claim 10:
The managing apparatus as claimed in claim 9, further comprising:
means for instructing delivery and/or settlement of an item depending on a commercial

transaction which is made in the virtual world in which the virtual personal information is used, based on the real personal information.

> **Shiloh teaches:**
> "**Payments by virtual personalities over the Internet may be in the form of a virtual credit/debit card registered to your fictional personality. This may be implemented with real credit card numbers** that may be issued to Virtunality by existing credit card companies." (pg. 5, para.2) Payment involves settlement and real credit card numbers issued by credit card companies will require real personal information.**

Regarding claim 11:

The managing apparatus as claimed in claim 9, further comprising:
means for seeking confirmation on an approval of a settlement to an individual in the real world who made a commercial transaction in the virtual world in which the virtual personal information is used, based on the virtual personal information.

> **Shiloh teaches:**
> "**All financial tools (e.g., credit cards, debit cards) registered to virtual users of Virtunality will be billed to Virtunality, and the payments will be deducted within Virtunality from the debit accounts of the corresponding real users. Using this system, users will also be able to receive payments and refunds credited to their virtual personalities." (pg. 3, para. 3)**

Regarding claim 12:

A system for managing a virtual city space within a virtual world, comprising:
a plurality of virtual shops accessible via a network,

> **Shiloh teaches:**
> **In the drawing "Proposed Model for Virtuanlity" is "Internet Shopping" with Pets.com and Pricline.com as examples of virtual shops.**

a commercial transaction being made between a first virtual individual and an arbitrary one of the virtual shops, based on virtual personal information of the first virtual individual,

> **Y@Virtunality.com (User "Y" with SS#, billing address) access to Internet Shopping (see above drawing).**

wherein said virtual personal information has a representation format similar to that of real personal information of a real world, and includes a virtual address in the virtual city space within the virtual world.

> "**To accommodate products that are available only via shipping, Virtunality will establish physical mailboxes that will be assigned to subscribers, under their virtual identity**, based on a reasonable monthly fee." (pg. 5, para. 1) Virtuanlity is a virtual world. Inherent in virtual mailboxes in a virtual world are virtual addresses.**

**Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh also teaches billing address (figure "Proposed Model For Virtuanlity") as real personal information.
Shiloh fails to disclose "virtual city."
Ferreira, also in the business of virtual worlds teaches a virtual city:**

> **"The virtual city application may provide one-stop shopping services while not burdening users with repeated requests for personal information." [¶0012]**

It would have been obvious to one of ordinary skill in the art at the time of invention to teach "virtual city" in the virtual world of Shiloh motivated by Ferreira and that a virtual city would represent a virtual billing address component that would be linked to the real billing address components (name, street, city, state, etc) taught by Shiloh.

Regarding claim 13:
The system as claimed in claim 12, further comprising:
a virtual home of a second virtual individual having a virtual address in the virtual city space, and

> **Shiloh teaches:**
> **User "Y" ("Proposed Model for Virtuality")**

a communication being made between the first virtual individual and the second virtual individual, based on the virtual personal information of the first virtual individual.

> **"Such services may include an online automatic dating expert (e.g., a "hit-line" generator), an online "famous quote" generator, an online "trivia generator", an online business expert, online automatic translation of "e-language", and/or any other tools that may improve the social skills of interested users." (pg. 6, para. 1)**

> **Also, access to "Chat rooms" ("Proposed Model for Virtuality")**

Regarding claims 14 and 15:
(claim 14) The system as claimed in claim 13, further comprising:
a virtual station through which the first virtual individual can move to another virtual city space.
(claim 15) Thespace svstem as claimed in claim 12, further comprising:
a virtual station through which the first virtual individual can move to another virtual city space.

The combined references teach virtual city, they do not teach moving to another virtual city.

Ferreira, also in the business of virtual worlds teaches a virtual city:

> **"The <u>virtual city application</u> may also provide <u>virtual travel</u> and tourism
> features. For example, interest-specific virtual tours may be provided
> whereby users may take virtual tours based on particular preferences (e.g.,
> jazz in New Orleans). The virtual tours may include visits to parades,
> museums, clubs, restaurants, or any other suitable event or location."
> [0020]**

**It would have been obvious to one of ordinary skill in the art at the time of
invention to allow for moving or traveling to different virtual cities, motivated by
Ferreira, and that this would be similar to traveling to different cities in the real
world.**

<u>Regarding claim 16:</u>
A method, comprising:
communicating, via a network, virtual information of a virtual user to at least one of a
plurality of virtual entities within a virtual world, both the virtual user and the plurality of
virtual entities representing a real person and real entities;

> **<u>Shiloh teaches:</u>**
> **"Proposed Model For Virtuality" that includes: 1) a network… Internet; 2)
> plurality of virtual users…Virtual users (User "X" and User "Y); 3) plurality
> of virtual entities (Internet Shopping; Chat rooms).**

managing registered information of the virtual user and real user to convert virtual
information into real information of a person; and

> **"Virtuality, on its real world side, will know the <u>linking between your real
> information and your virtual information</u>. The Internet side of Virtuality will
> communicate only with the virtual person you have created."(pg. 3, para. 2)**

> **"The <u>linking between real identities and their corresponding virtual
> identities</u>, for both debit and credit purposes, <u>will be performed</u> only within
> the <u>internal accounting system of Virtuality</u>, thereby fully protecting this
> crucial linking from being communicated to the Internet." (pg. 3, para. 4)
> Inherent in this process is converting virtual to real information using the
> Virtuality system**

> **(see Register below)**

notifying the real personal information to an entity.

> **"Virtuality will create its own line of virtual products, which <u>will be offered
> to Virtuality users</u> for a charge. For example, Virtuality will create a
> series <u>of exclusive (e.g., copyrighted and/or trademarked) virtual
> personalities, having predefined attributes</u>. These personalities will be sold**

to interested Virtunality users, e.g., using an auction-type system. The buyers of such predefined virtual personality will become the legal owners of the intellectual property rights to their virtual personalities. The <u>virtual personalities may be the equivalent of any real world entity</u>, such as people, animals (e.g., pets), or corporations." (Pg. 5, para. 3) Real personal information is offered to Virtuanlity users.

Register
Shiloh discloses real and virtual worlds, linking real personal information between real and virtual worlds. Shiloh does not teach register.

Ferreira, also in the business of virtual worlds teaches:
"By linking all order processes from all e-commerce web sites accessible through the virtual city application, the user is given the ability to shop for items at multiple places, each purchase being made through a single source. This allows the user to register only once." [¶ 0085]

It would have been obvious to one of ordinary skill in the art at the time of invention to teach register motivated by Ferreira and that this would provide real personal information such as billing address, for example, and this would allow Virtunality to make payments for users.

11.   Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the

combined references in section (10) above in further view of Official Notice.

Regarding claim 6:
The electronic commercial transaction method as claimed in claim 2, further comprising: approving log-in to the virtual world; and
Shiloh teaches:
"Virtunality will endorse and encourage anonymity on the Internet and will provide its users with powerful tools to interact anonymously with the Internet." (pg. 1, para. 3)

(Also below regarding log-in)

approving the commercial transaction in the virtual world.
"Virtunality will enable its users to spend money anonymously on the Internet by providing virtual users with buying power in the form of virtual spending accounts. Using your virtual accounts with Virtunality, you will be able to research and <u>shop the Internet, receive royalties, do business, etc</u>. - - basically taking care of all your Internet needs and many real world needs

-- without ever disclosing any details linked to your real identity." (pg. 1, para. 1 and pg. 2, top para.) Inherent in shopping and doing business would be approval of commercial transactions.

While Shiloh teaches anonymity on the Internet, he does not teach logging into a virtual world. However, the Examiner takes Official Notice that logging into a virtual world such as logging onto the Internet is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to require logging into a virtual world, and that enhance the anonymity on the Internet of a user of Shiloh's Virtuality.

Regarding claim 7:
The electronic commercial transaction method as claimed in claim 6, wherein said approving the log-in and said approving the commercial transaction, respectively, approve based solely on the virtual personal information.
    Shiloh teaches:
    "Virtuality will enable its users to spend money anonymously on the Internet by providing virtual users with buying power in the form of virtual spending accounts. Using your virtual accounts with Virtuality, you will be able to research and shop the Internet, receive royalties, do business, etc. -- basically taking care of all your Internet needs and many real world needs -- without ever disclosing any details linked to your real identity." (pg. 1, para. 1 and pg. 2, top para.) Therefore, only virtual information is provided.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

| US Pub. No. | 2002/0055833 | Sterling |
| US Pub. No. | 2001/0056377 | Kondoh et al. |

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to KENNETH L. BARTLEY whose telephone number is

(571)272-5230. The examiner can normally be reached on Monday through Friday,

8:00 - 5:00 EST.

　　　　If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693